

U. S. Circuit Court. Southern Dist.
of New York

National Phonograph Co.,	}	In Equity
Edison Phonograph Works		No. 6434 &
& N. Y. Phonograph Co.		6435.
vs.		on various
Columbia Phonograph Co. &	}	patents.
Edward D. Easton		

BILLS OF COMPLAINT & DISCONTINUANCES
1896

American Phonograph Company and Jesse H. Lip- 109
pincott. August 1, 1888. Agreement, made this
1st day of August, 1888, by and between Thomas
A. Edison, of Llewellyn Park, etc. (Note: The
agreement is identical with the copy of the same
agreement set forth in Complainant's Exhibit 46,
March 18, 1903, J. A. S. Ex'r.)

[Note. The original of the foregoing affidavit of
Thomas A. Edison and of the copy of agreement of
August 1, 1888, annexed, are printed on pages and
folios numbered consecutively as follows: The af-
fidavit, pages 29-45, folios 113-180; agreement,
pages 46-49, folios 181-196. The last page of the
affidavit is page 45, and it bears the signature 110
"Thomas A. Edison," the jurat and the notary's
seal. Page 46 is the first page of the agreement
and is the reverse side of the leaf of page 45, so
that the said notary's seal shows in negative on
page 46, being impressed directly into the paper.]

(Endorsed:) United States Circuit Court. Filed
March 28, 1895. John A. Shields, Clerk.

**Complainant's Exhibit 10, December
8, 1902, J. A. S., Ex'r.**

No. 6434.

To the Honorable the Judges of the United States
Circuit Court for the Southern District of 111
New York.

National Phonograph Company and Edison
Phonograph Works, both being corporations or-
ganized and existing under and pursuant to the
laws of the State of New Jersey and having their
principal places of business at the City of Orange
in said State, and New York Phonograph Com-
pany a corporation organized and existing under
and pursuant to the laws of the State of New York,
and having its principal place of business in the
City of New York in said State, bring this their

112 bill of complaint against the Columbia Phonograph Company, a corporation organized and existing under and pursuant to the laws of the State of West Virginia, and Edward D. Easton, individually and as president of said Columbia Phonograph Company, said Easton being a resident of Washington in the District of Columbia, and a citizen of the said District of Columbia, and both the said The Columbia Phonograph Company and said Edward D. Easton individually and as president as aforesaid, being engaged in the transaction of business, as hereinafter complained of, in the City of New York, within the District aforesaid.

113 And thereupon your orators complain and say:

That on and prior to the 8th day of May, 1888, Thomas A. Edison, being then a citizen of the United States, and a resident of Llewellyn Park in the County of Essex, and State of New Jersey, was the original and first inventor of certain new and useful improvements in phonogram blanks, and that the said invention was not known or used, and had not been patented or described in any printed publication before his invention thereof, and had not been in public use or sale for more than two years prior to his application for letters patent therefor, hereinafter mentioned, and had not been abandoned to the public.

114 That said Edison made due application in writing to the Commissioner of Patents of the United States for the grant of letters patent for said invention, and paid into the treasury of the United States the fees required by law, and then and there fully and in all respects complied with all the necessary conditions and requirements of the statutes of the United States in such case made and provided, and thereupon after due examination having been made by the Commissioner of Patents as to the novelty and utility of said invention, as

provided by law, the Commissioner of Patents 115
caused to be issued to said Edison, letters patent in
due form of law under the seal of the Patent Of-
fice of the United States, signed by the Secretary of
the Interior, and countersigned by the Commis-
sioner of Patents, and bearing date the
said 8th day of May, 1888, and numbered
382,418, and that the said Letters Patent did
grant unto the said Edison, and his heirs and
assigns for the term of seventeen years from the
date thereof, the exclusive right to make, use and
vend the said invention throughout the United
States and the territories thereof as by said letters
patent or a duly authenticated copy thereof in 116
court to be produced will more fully and at large
appear.

That on and prior to the 8th day of May, 1888,
said Thomas A. Edison being then a citizen of the
United States and a resident of Llewellyn Park in
the County of Essex, State of New Jersey, was the
original and first inventor of certain new and use-
ful improvements in phonogram blanks, and that
the said invention was not known or used and had
not been patented or described in any printed pub-
lication before his invention thereof, and had not
been in public use or on sale for more than two
years prior to his application for letters patent 117
therefor, hereinafter mentioned, and had not been
abandoned to the public.

That the said Edison made due application in
writing to the Commissioner of Patents of the
United States for the grant of letters patent for
said invention, and paid into the treasury of the
United States the fees required by law, and then
and there fully and in all respects complied with
all the necessary conditions and requirements of
the statutes of the United States in
such case made and provided, and there-

118 upon, after due examination having been made by the Commissioner of Patents as to the novelty and utility of said invention as provided by law, the Commissioner of Patents caused to be issued to said Edison, letters patent in due form of law under the seal of the Patent Office of the United States, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, bearing date the said 8th day of May, 1888, and numbered 382,462, and that the said letters patent did grant unto the said Edison his heirs and assigns for the term of seventeen years from the date thereof, the exclusive right to make, use and vend the said invention throughout the United States and the territories thereof, as by said letters patent or a duly authenticated copy thereof in court to be produced will more fully and at large appear.

119 That on and prior to the second day of April, 1889, said Thomas A. Edison, being then a citizen of the United States, and a resident of Llewellyn Park, in the County of Essex, and State of New Jersey, was the original and first inventor of certain new and useful improvements in phonogram blanks, and that the said invention was not known or used and had not been patented or described in any printed publication before his invention thereof, and had not been in public use or on sale for more than two years prior to his application for letters patent therefor, hereinafter mentioned, and had not been abandoned to the public.

120 That said Edison made due application in writing to the Commissioner of Patents of the United States, for the grant of letters patent for said invention and paid into the treasury of the United States the fees required by law, and then and there fully and in all respects complied with all the necessary conditions and requirements of the statutes

of the United States in such case made and provided, and thereupon after due examination having been made by the Commissioner of Patents as to the novelty and utility of said invention, as provided by law, the Commissioner of Patents caused to be issued to said Edison, letters patent in due form of law under the seal of the patent office of the United States, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and bearing date the said second day of April, 1889, and numbered 400,648, and that the said letters patent did grant unto the said Edison and his heirs and assigns for the term of seventeen years from the date thereof, the exclusive right to make, use and vend the said invention throughout the United States and the territories thereof, as by said letters patent, or a duly authenticated copy thereof, in court to be produced, will more fully and at large appear. 121 122

That on and prior to the 12th day of November 1889, said Thomas A. Edison, being then a citizen of the United States, and a resident of Llewellyn Park in the County of Essex and State of New Jersey, was the original and first inventor of certain new and useful improvements in phonogram blanks, and that the said invention was not known or used and had not been patented or described in any printed publication before his invention thereof, and had not been in public use or on sale for more than two years prior to his application for letters patent therefor, hereinafter mentioned, and had not been abandoned to the public. 123

That said Edison made due application in writing to the Commissioner of Patents of the United States, for the grant of letters patent for said invention, and paid into the treasury of the United States the fees required by law, and then and there

- 124 fully and in all respects complied with all the necessary conditions and requirements of the statutes of the United States in such case made and provided, and thereupon, after due examination having been made by the Commissioner of Patents as to the novelty and utility of said invention as provided by law, the Commissioner of Patents caused to be issued to said Edison, letters patent in due form of law under the seal of the Patent Office of the United States, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents and bearing date the said 12th day of November, 1889, and
- 125 numbered 414,761, and that the said letters patent did grant unto the said Edison and his heirs and assigns for the term of seventeen years from the date thereof, the exclusive right to make, use and vend the said invention throughout the United States and the territories thereof, as by said letters patent, or a duly authenticated copy thereof in Court to be produced, will more fully and at large appear.

That on and prior to the 17th day of June, 1890, said Thomas A. Edison, being then a citizen of the United States, and a resident of Llewellyn Park in the County of Essex and State of New Jersey, was the original and first inventor of certain new and useful improvements in phonogram blanks, and that the said invention was not known or used, and had not been patented or described in any printed publication before his invention thereof, and had been in public use or on sale for more than two years prior to his application for letters patent therefor, hereinafter mentioned, and had not been abandoned to the public.

That said Edison made due application in writing to the Commissioner of Patents of the United States for the grant of letters patent for said in-

vention, and paid into the treasury of the United States the fees required by law, and then and there fully and in all respects complied with all the necessary conditions and requirements of the statutes of the United States in such case made and provided, and thereupon after due examination having been made by the Commissioner of Patents as to the novelty and utility of said invention, as provided by law, the Commissioner of Patents caused to be issued to said Edison letters patent in due form of law under the seal of the Patent Office of the United States, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and bearing date the said 17th day of June, 1890, and numbered 430,274, and that the said letters patent did grant unto the said Edison and his heirs and assigns for the term of seventeen years from the date thereof, the exclusive right to make, use and vend the said invention throughout the United States and the territories thereof, as by said letters patent, or a duly authenticated copy thereof in court to be produced, will more fully and at large appear. 127

Your orator, National Phonograph Company shows that by virtue of a certain assignment in writing dated the 5th day of October, 1896, it became, has ever since been, and now is, possessed of the full and entire right, title and interest in and to each and all of the aforesaid Letters Patent save as hereinafter set forth, together with any and all right or rights of action, claims and demands whatsoever for damages or profits, or both, accruing under the same subsequent to the 16th day of January, 1896, with full right to sue upon and collect the same for its own use and behoof. 129

Your orator, Edison Phonograph Works, shows that prior to the performance of the acts herein-after complained of, it became, has ever since been,

130 and now is, vested with the sole and exclusive right, liberty and license to manufacture under each and all of the Letters Patent aforesaid.

Your orator, New York Phonograph Company, avers that prior to the performance of the acts hereinafter complained of, it became, has ever since been, and now is, vested with the sole and exclusive right, liberty and license to sell, within the State of New York, the several devices covered by said several Letters Patent.

131 Your orators, National Phonograph Company and Edison Phonograph Works, therefore show unto your Honors that prior to the performance of the acts hereinafter complained of, they became, have ever since been, and now are, possessed of the full and entire estate under the said several Letters Patent within said District, save and except in so far as the same may be affected by the claim of your orator, New York Phonograph Company, of the right to sell devices manufactured under said Letters Patent.

132 And your orators further show that the said several inventions are of great commercial value and practical utility; that a great public interest has been manifested therein and a large demand created for devices constructed in accordance with or embodying the same. That in order to supply this demand and to confer upon the public the benefits and advantages under said Letters Patent your orators and their predecessors in interest have invested and expended large sums of money in adapting and perfecting such devices and in devising and constructing special machinery tools, and appliances for the manufacture of the same, and that they are and have been since a period prior to the performance of the acts hereinafter complained of, so equipped and otherwise prepared as to be able to supply the market with phono-

graphs and appliances therefor, phonogram blanks 133
employing and containing the said several inventions, and that they have been and are in fact placing upon the market phonogram blanks in large quantities, manufactured under said several Letters Patent and duly marked with the word "Patented" and the dates of the several Letters Patent aforesaid in the manner provided by law.

Your orators further show that the said several inventions or improvements described and claimed in said several Letters Patent were designed for and are capable of use conjointly, and that in the defendants' structures hereinafter complained of they are so used. 134

Yet the defendants, well knowing the premises and the rights secured to your orators as aforesaid, but contriving to injure them and to deprive them of the benefits and advantages which might and otherwise would accrue unto them from the said several inventions, after the acquiring of your orators' interest as hereinbefore set forth and before the commencement of this suit, did, jointly as well as severally, as your orators are informed and believe, within the Southern District of New York and elsewhere within the United States, without license or allowance, and against the will of your orators and in violation of their rights, unlawfully and wrongfully make, use and sell, or cause to be made, used and sold, and are now making, using and selling, or causing to be made, used and sold, phonogram blanks employing and containing conjointly the inventions set forth in said several Letters Patent, that they still continue so to do, and that they are threatening to continue the aforesaid unlawful acts to a large extent, all in defiance of the rights secured to your orators as aforesaid and to their great and irreparable loss and injury, and by which they have been 135

136 and still are being deprived of great gains and profits which they might and otherwise would have obtained, but which have been received and enjoyed by the said defendants through their aforesaid unlawful acts and doings. And your orators show that as to the amount of such gains and profits had and received by the said defendants, they are ignorant and pray a discovery thereof.

More specifically your orators show that American Graphophone Company, a West Virginia corporation having an office for the transaction of business at Washington in the District of Columbia, and a factory for the construction of sound recording and re-producing devices at the City of
137 Bridgeport in the State of Connecticut, is engaged in the business of manufacturing, using and vending sound recording and reproducing devices in conjunction with which, as well as in conjunction with the sound recording and reproducing devices made, used and sold by your orators, phonogram blanks made under and employing and containing the several inventions in said several Letters Patent set forth, are capable of use. And your orators show that certain of the phonogram blanks hereinbefore complained of as employing and containing the inventions in said several Letters Patent set forth, were, after the acquiring of
138 your orators' interest in said Letters Patent and prior to the commencement of this suit, manufactured by the said American Graphophone Company at its factory at Bridgeport, Connecticut, or elsewhere within the United States, and, by the defendants, The Columbia Phonograph Company and Edward D. Easton, acting jointly as well as severally, sold and put into use in the City of New York within the Southern District of New York as aforesaid. And your orators further show that said Easton is the president and managing official

of said American Graphophone Company and of said The Columbia Phonograph Company, and that in that capacity he procured and promoted, within the period aforesaid and at the places mentioned, the use and sale of said phonogram blanks in violation of your orators' rights under said several Letters Patent. 139

And your orators further show unto your Honors, on information and belief, that the said defendants, and each of them, had notice of the said Letters Patent and each of them and of their infringement thereof, prior to the filing of this bill of complaint. They further show that the manufacture, use and sale of phonogram blanks employing and containing the said several inventions set forth in said several Letters Patent by the said defendants, and their preparation for and avowed determination to continue the same and their other unlawful acts in disregard and defiance of the rights of your orators, have the effect to and do encourage and induce others to venture to infringe said several Letters Patent to your orators' great loss and injury. 140

Your orators therefore pray that the said defendants, the Columbia Phonograph Company and Edward D. Easton, individually and as president of the said The Columbia Phonograph Company and their and each of their servants, agents, attorneys, employees, workmen and confederates, and each and every of them, may be perpetually restrained and enjoined by the order and injunction of this Honorable Court from directly or indirectly making, constructing, using, vending and delivering, working or putting into operation or use, or in any wise counterfeiting or imitating the said several inventions or any part or parts thereof, or any phonogram blank or blanks for sound recording and reproducing 141

- 142 machines made or operated in accordance therewith, or like or similar to those which the said defendants have heretofore made, sold, constructed, operated or used. Your orators further pray that the said defendants may be required to account for and pay unto your orators all the gains and profits which have accrued or arisen out of the acts hereinbefore complained of, and all the gains and profits which would have accrued to your orators but for the said unlawful acts and doings and all damages your orators have sustained thereby. Your orators further pray that the said defendants may be decreed to pay the costs of this suit and that
- 143 your orators may have such other and further relief as to this Honorable Court shall seem meet, and as shall be agreeable to equity.

May it please your Honors to grant unto your orators the writ of injunction *pendente lite* issuing out of and under the seal of this Honorable Court, commanding, enjoining and restraining the said The Columbia Phonograph Company and Edward D. Easton, individually and as President of said company, and their and each of their servants, agents, attorneys, employees, workmen and confederates, and each and every one of them, during the pendency of this suit, as hereinbefore in that behalf prayed in regard to said perpetual injunction.

144

And forasmuch as your orators can have no adequate relief, save in this court, to the end therefore that the said defendants may, if they can, show why your orators should not have the relief hereby prayed, and may, but not upon oath, answer under oath being hereby expressly waived, according to their and each of their best and utmost knowledge, remembrance, information and belief, full, true, direct and perfect answer make to the premises and to all the several matters hereinbefore

stated and charged, as fully and particularly as if 145
severally and separately interrogated as to each
and every of said matters:

May it please your Honors to grant unto your
orators the writ of subpoena issuing out of and under
the seal of this Honorable Court directed to
the said defendants The Columbia Phonograph
Company and Edward D. Easton, individually and
as president of said company, commanding them
by a certain day and under a certain penalty to be
and appear in this Honorable Court, then and there
to answer to the premises, and to stand to and
abide such order and decree as may be made against
them.

146

And your orators will ever pray, &c.,

(Signed.) National Phonograph Company,

By John F. Randolph,

Treasurer.

Edison Phonograph Works,

By Thomas A. Edison,

President.

New York Phon. Company,

By Noah Davis,

Attorney.

Dyer & Driscoll,

Solicitors for Complainants.

Richard N. Dyer,

S. O. Edmonds,

Counsel for Complainants.

Noah Davis,

A. L. Pincoffs,

Of Counsel for the New York Phonograph Co.

State of New Jersey, } ss.:
County of Essex, }

147

John F. Randolph, being duly sworn, deposes
and says, that he is the treasurer of National
Phonograph Company, one of the complainants

- 148 named in the foregoing bill of complaint; that he has read said bill of complaint, and knows the contents thereof; that the same is true to his own knowledge, except as to such matters as are alleged upon information and belief, and as to those matters he believes it to be true.

John F. Randolph.

Subscribed and sworn to before me }
this 8th day of October, 1896. }

Alexander Elliott, Jr.,

[NOTARY'S SEAL.] Notary Public,
of New Jersey.

- 149 (Endorsed:) United States Circuit Court, Southern District of New York. National Phonograph Company, Edison Phonograph Works and New York Phonograph Company vs. The Columbia Phonograph Company and Edward D. Easton, individually and as president of said company. Bill of complaint (on patents Nos. 382,418, 382,462, 400,648, 414,761 and 430,274). Dyer & Driscoll, Complainants' Sol'rs., 36 Wall street, N. Y. City, N. Y. U. S. Circuit Court, Filed, Oct, 9, 1896. John A. Shields, Clerk.

Complainant's Exhibit 11, December 8, 1902, J. A. S., Ex'r.

150

Complainant's Exhibit 11 is identical with Complainant's Exhibit 10, with the following exceptions: No. 6434 should be No. 6435; in par. 2 "8th day of May, 1888" should be "31st day of July, 1888" and "improvements in phonogram blanks" should be "improvements in phonographs"; in par. 3, "8th day of May, 1888" should be "31st day of July, 1888" and "numbered 382,418" should be "numbered 386,974"; in par. 4, "8th day of May, 1888" should be "17th day of June, 1890" and "improvements in phonogram blanks" should be

“improvements in phonographs”; in par. 5, “8th day of May, 1888” should be “17th day of June, 1890” and “numbered 382,462” should be “numbered 430,278”; in par. 6 “second day of April, 1889” should be “18th day of October, 1892” and “improvements in phonogram blanks” should be “improvements in phonograph cutting tools”; in par. 7, “second day of April, 1889” should be “18th day of October, 1892” and “numbered 400,648” should be “numbered 484,583”; in par. 8, “12th day of November, 1889” should be “18th day of October, 1892” and “improvements in phonogram blanks” should be “improvements in phonograph reproducers”; in par. 9, “12th day of November, 1889” should be “18th day of October, 1892” and “numbered 414,761” should be “numbered 484,584”; in par. 10, “17th day of June, 1890” should be “20th day of June, 1893” and “improvements in phonogram blanks” should be “improvements in phonographs”; in par. 11, “17th day of June, 1890” should be “20th day of June, 1893” and “numbered 430,274” should be “numbered 499,879”; in par. 16, “to supply the market with phonogram blanks” should be “to supply the market with phonographs and appliances therefor”; par. 19 of Exhibit 11 contains several differences from par. 19 of Exhibit 10, and is in full as follows:

“More specifically your orators show that American Graphophone Company, a West Virginia corporation having an office for the transaction of business at Washington in the District of Columbia, and a factory at the City of Bridgeport in the State of Connecticut, is engaged at the latter place in the manufacture, use and sale of sound recording and reproducing devices employing and containing the aforesaid inventions in phonographs and appliances therefor. And your orators show that certain of the sound-recording and reproducing de-

- 154 vices employing and containing the said several inventions in said Letters Patent set forth, were, after the acquiring of your orators' interest in said Letters Patent and prior to the commencement of this suit, manufactured by the said American Graphophone Company at its factory at Bridgeport, Connecticut, and elsewhere within the United States, and, by the defendants, The Columbia Phonograph Company and Edward D. Easton, acting jointly as well as severally, sold and put into use in the City of New York within the Southern District of New York as aforesaid. And your orators further show that said Easton is the President and managing official of said American Graphophone Company and of said The Columbia Phonograph Company, and that in that capacity he procured and promoted, within the period aforesaid, and at the places mentioned, the use and sale of said sound-recording and reproducing devices in violation of your orators' rights under said several Letters Patent."
- 155

- In par. 20, "the manufacture, use and sale of phonogram blanks" should be "the manufacture, use and sale of phonographs and appliances therefor"; in par. 21, "or any phonogram blank or blanks for sound-recording and reproducing machines" should be "or any phonograph or phonographs or appliances therefor or sound-recording and reproducing machines." The remaining part of Exhibit 11 are identical with the remaining part of Exhibit 10, including the signatures to the bill and the verification; the endorsement, however, of Exhibit 11, is identical with the endorsement of Exhibit 10, except that "(On Patents Nos. 382,418; 382,462; 400,648; 414,761 and 430,274)" should be "(On Patents Nos. 386,974; 430,278; 484,583; 484,584 and 499,879)."
- 156

Complainant's Exhibit 12, December 157
8, 1902, J. A. S., Ex'r.

UNITED STATES CIRCUIT COURT,
SOUTHERN DISTRICT OF NEW YORK.

NATIONAL PHONOGRAPH COM-
PANY, Edison Phonograph
Works and New York Phono-
graph Company

against

In Equity.

THE COLUMBIA PHONOGRAPH
COMPANY and Edward D.
Easton.

158

On consent of the respective parties hereto, it is hereby

Ordered that this suit be, and the same hereby is, discontinued, without costs to either party as against the other.

E. HENRY LACOMBE,
 Circuit Judge.

We hereby consent to the entry and filing of the above order.

159

DYER & DRISCOLL,
 Complainants' Solicitors.

LEE & LEE,
 Defendants' Solicitors.

By POLLAK & MAURO,
 Of Counsel.

Endorsed: United States Circuit Court. South-
ern District of New York. In Equity. National
Phonograph Company, Edison Phonograph Works
and New York Phonograph Company against The
Columbia Phonograph Company and Edward D.

- 160 Easton. Order of Discontinuance on Patents Nos. 382,418; 382,462; 400,648; 414,761 and 430,274. Dyer & Driscoll, for complainants. 36 Wall street, New York, N. Y. U. S. Circuit Court, filed December 9, 1896. John A. Shields, Clerk.

Complainant's Exhibit 13, December 8, 1902, J. A. S., Ex'r.

UNITED STATES CIRCUIT COURT,
SOUTHERN DISTRICT OF NEW YORK.

- 161 NATIONAL PHONOGRAPH COMPANY, Edison Phonograph Works and New York Phonograph Company

against

THE COLUMBIA PHONOGRAPH COMPANY and Edward D. Easton.

In Equity.

On consent of the respective parties hereto, it is hereby

- 162 Ordered that this suit be, and the same hereby is, discontinued, without costs to either party as against the other.

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Circuit Judge.

We hereby consent to the entry and filing of the above order.

DYER & DRISCOLL,
Complainants' Solicitors.

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By POLLAK & MAURO,
Of Counsel.